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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/734,563

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Joseph A. Sorge

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Agilent Technologies, Inc. in care of:  
CPA Global  
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Minneapolis, MN 55402

EXAMINER

HUTSON, RICHARD G

ART UNIT

PAPER NUMBER

1652

NOTIFICATION DATE

DELIVERY MODE

04/07/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPOPS.LEGAL@agilent.com  
Agilentdocketing@cpaglobal.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/734,563	<b>Applicant(s)</b> SORGE ET AL.	
	<b>Examiner</b> RICHARD HUTSON	<b>Art Unit</b> 1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 22-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/8/2011</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicant's amendment of claims 1-7, in the paper of 1/28/2011, is acknowledged. Claims 1-26 are still at issue and are present for examination. Applicants' arguments filed on 1/28/2011 have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Applicant's previous election with traverse of Group I and SEQ ID NO:89, Claims 1-10 and 12-21 in the paper of 10/23/2006, is acknowledged.

The Decision rendered by the Board of Patent Appeal and Interferences on 7/20/2010, in which the previous rejections under 112 first paragraphs for the species of SEQ ID NO:89 were reversed, is acknowledged.

Claims 11 and 22-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. It is noted that as indicated in the previous interview summary, the claims as directed to mutants of SEQ ID NO:89 are deemed allowable and thus the examiner has moved on to the examination of an additional species of the generic claims (i.e. SEQ ID NO:108).

Additionally it is noted that the examiner has previously contacted applicant's representative to discuss the claims following the Board's decision:

### ***Claim Objections***

Claims 1-10 and 12-21 are objected to because of the following informalities:

Claims 1-7 are objected to because the claims recite V93 of SEQ ID NO:89” and also recite “corresponding residue ... from one of the other sequences of SEQ ID NOs. 83-108”. Thus applicant’s claims refer to SEQ ID NO:89 twice.

Claims 1-10 and 12-26 are objected to because the claims comprise non-elected subject matter.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 and 12-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 (claims 8-10 and 12-21 dependent from) were previously rejected under this statute for the recitation “an amino acid mutation at V93 in an amino acid sequence selected from one of SEQ ID No’s 83-108” being indefinite on the basis that SEQ ID NO:108 does not have an amino acid position V93. In response to this rejection applicants have amended the claims and argue this rejection as it applies to the newly amended claims.

Applicants claims now recite “an amino acid mutation of V93 of SEQ ID NO:89 or a corresponding residue in an amino acid sequence selected from one of the other sequences of SEQ ID NOs. 83-108”.

Applicants submit that they have amended the claims to recite the mutation is at residue V93 of SEQ ID NO:89 or a corresponding residue at one of the other sequences recited in the claims.

The claims remain indefinite on the basis that it is indefinite and unclear as to which residue of the other amino acid sequences is a corresponding residue. Is the corresponding residue of the other sequences a valine residue or is it any amino acid at position 93 of these sequences. As previously pointed out to applicants in SEQ ID NO:108 there is no V93. Is the corresponding residue V92, V99, or D93? Similar confusion results in examination of many of the other amino acid sequences also.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 and 12-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection was stated in the previous office action as it applied to previous claims. In response to this rejection applicants have amended the claims and argue the rejection as it applies to the newly amended claims

Applicants submit that the amendment addresses the Office's concern as to the absence of a V93 residue in SEQ ID NO: 108 and applicants submit that all of their prior arguments with regard to enablement and the adequacy of the written description for the claimed mutants, within the context of currently examined SEQ ID NO: 108, are applicable to SEQ ID NO: 108, and that the Board's decision should be controlling to the extent that the Office further considers patentability of the claims under 35 U.S.C. § 112, first paragraph.

Applicants amendment of the claims and applicants complete argument as well as the prior Board Decision are acknowledged and have been carefully considered, however, are not found persuasive for the reasons previously made of record and for those reasons repeated herein.

It continues that applicants have not adequately described those Archaeal DNA polymerases comprising a mutation at a position corresponding to V93 of SEQ ID NO:89 in the amino acid sequence of SEQ ID NO: 83-108. As previously stated, the specification, does not provide a single species of that polypeptide comprising the amino acid mutation corresponding to V93 of SEQ ID NO:89, in an amino acid sequence of SEQ ID NO:108, on the basis that as discussed above, SEQ ID NO:108 does not comprise an amino acid position V93 and that position corresponding to V93 is indefinite. It is additionally noted that many additional sequence of SEQ ID NO:83-108 do not comprise a V93 or a residue corresponding to V93. (See above rejection under 112 second paragraphs). Thus there is no disclosure of any particular structure to function/activity relationship in the claimed species. Given this lack of additional

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representative species as encompassed by the claims, Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention.

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at [www.uspto.gov](http://www.uspto.gov).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G. Hutson whose telephone number is 571-272-0930. The examiner can normally be reached on M-F, 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mondesi Robert can be reached on 571-272-0956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rgH  
4/1/2011

/Richard G Hutson/  
Primary Examiner, Art Unit 1652